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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/521,640 03/10/00 BYRUM

J 04983.0120.u

028381 HM12/0919  
ARNOLD & PORTER  
IP DOCKETING DEPARTMENT; RM 1126(B)  
555 12TH STREET, N.W.  
WASHINGTON DC 20004-1206

EXAMINER

BORIN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

09/19/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/521,640

Applicant(s)

Byrum et al.

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **Part III DETAILED ACTION**

Claims 1-15 are currently pending.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to isolated nucleic acid hybridizable to a nucleic acid of SEQ ID Nos 1-304950, their fragments and complements, classified in class 536, subclass 23.1.
- II. Claims 8-10, drawn to a purified nucleic acid comprising end sequences identified in Table A, classified in class 536, subclass 23.1.
- III. Claim 11, drawn to a purified polypeptide, classified in class 530, subclass 300.
- IV. Claims 12-15 drawn to a transformed plant, classified in class 800, subclass 205.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are considered to be structurally and functionally different as there is nothing in the claims suggesting that they have any common structure elements. The examination of the Groups will require different searches of the US Patents and scientific literature

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and would require consideration of different patentability issues. A reference teaching one sequence (e.g., of group I) would not teach a sequence of any flanking region (i.e., of Group II).

Inventions I and III are separate and distinct because the inventions are directed to different chemical types regarding the critical limitations therein. For Group III, the critical feature is a polypeptide whereas for Group I the critical feature is a polynucleotide. It is acknowledged that various processing steps may cause a polypeptide of group III to be directed as to its synthesis by a polynucleotide of Group I, however, the completely separate chemical types of the inventions of Groups I and II supports the undue search burden if both were examined together. Additionally, polypeptides have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if examiner together, as compared to being searched separately. Also, it is pointed out that processing that may connect two groups does not prevent them from being viewed as distinct, because enough processing can result in producing any composition from any other composition if the processing is not so limited to additions, subtractions, enzyme actions, etc. In addition, neither the products in each Group, nor the products of Groups I and II share a common structure which elicits a common activity as to constitute a proper Markush listing. Accordingly, the claims of Groups I and III are drawn to improper generic and Markush claims.

Inventions of Groups II and III are structurally different products as claimed.

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Inventions I-III and IV are separate and distinct, as the claims of Invention I-III are drawn to polynucleotides and polypeptides, while the claims of group IV are drawn to a plant. These are differing biochemical entities having differing biochemical properties, structures and effects. Invention III would require searching in areas unrelated to polynucleotides and polypeptides, and as such, would require an undue burden on the examiner if not restricted.

***Sequence Election Requirement Applicable to All Groups***

In addition, each Group detailed above reads on a plurality of independent and/or patentably distinct sequences. Each peptide or nucleic acid sequence is independent and/or patentably distinct because they are unrelated compounds, there is no disclosed core structure required for a common utility, and because each of these compounds possess different structure and/or physico-chemical properties, and/or capable of separate manufacture and/or use. **For an elected Group the Applicants must further elect a single amino acid or nucleic acid sequence.**

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because of their recognized divergent subject matter, and the necessity for non-coextensive literature searches restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

#### **Species Requirement**

Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims.(MPEP 808.01(a))

If Group I is selected from above, the following election of species is hereby required for the initial search for examination on merits:

The claims of the Group are generic to a plurality of disclose patentably distinct species of nucleic acids which encompass a a variety of different compound species that require a burdensome classification, and/or bibliographic, manual and computer search. Claims 1-7 encompass species comprising various sequences such as microsattelite sequence, bacterial ORI site, promoter region,

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SNIP, etc. Accordingly, regardless of which group is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though the requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. MPEP 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

**MICHAEL BORIN, PH.D**  
**PRIMARY EXAMINER**

